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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054980
Party	Defendant Paisanos Pasta, LLC
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Trademark Registration No. 3,553,382

ANDONI, INC.

Petitioner

VS.

PAISANOS PASTA, LLC

Registrant

Cancellation No. 92054980

**PAISANOS PASTA, LLC’S MOTION FOR SANCTIONS, AND IN THE
ALTERNATIVE, TO COMPEL RESPONSES AND PRODUCTION RESPONSIVE
TO ITS DISCOVERY REQUESTS**

Pursuant to Rules 26, 33, 34, and 37 of the Federal Rules of Civil Procedure, Trademark Rule of Practice 2.120 and Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 403.04, 411.02, 411.05, 523 and 527.01, Registrant Paisanos Pasta (“Registrant”) respectfully moves the Board for an order:

(1) For dismissal against Petitioner as a sanction for its failure to respond to discovery; or

in the alternative,

(2) An order compelling Petitioner to answer completely, and without objection to Registrant's First Set of Interrogatories; and

(3) An order compelling Petitioner to produce, without objection, all documents responsive to Registrant's First Request for Production of Documents; and

(4) An order providing Registrant, only, a 30-day follow-up discovery period, or any other period which the Board deems just and reasonable.

This motion is supported by the Declaration of Bradley J. Levang ("Levang Dec."), submitted concurrently herewith.

I. Factual Background

On December 23, 2001, Petitioner commenced this proceeding by filing a Notice of Cancellation against Registrant's mark PAISANOS PASTA, U.S. Trademark Registration No. 3,553,382. Levang Dec. ¶ 4.

On June 29, 2012, Registrant served Petitioner with a first set of Interrogatories and a Request for Production of Documents (collectively "Discovery Requests"). Levang Dec. ¶ 5.

On July 31, 2012, Petitioner's counsel contacted Registrant's counsel seeking an extension of time to provide responses to the Discovery Requests. Levang Dec. ¶ 6. The parties agreed that Petitioner would have until August 10, 2012 to provide responses to the Discovery Requests. *Id.*

On August 9, 2012, Registrant's counsel received an email from Richard Litman, also counsel for Petitioner, and a voicemail message from Mr. Kubitz seeking a further extension of time for Petitioner to provide responses to the Discovery Requests. Levang Dec. ¶ 7.

On August 10, 2012, the parties agreed that Petitioner would have until August 24, 2012 to provide responses to the Discovery Requests. Levang Dec. ¶ 8.

On August 24, 2012, Petitioner's counsel contacted Registrant's counsel via telephone and represented that Petitioner did not have responses to the Discovery Requests. Levang Dec. ¶ 9.

On August 28, 2012, Registrant's counsel contacted Petitioner's counsel via email regarding the past due discovery seeking further verification that the representation on August 24, 2012 was an express representation that Petitioner would not be providing responses to the Discovery Requests. Levang Dec. ¶ 10. That same day, Petitioner's counsel responded to the portions of the email regarding settlement points, but did not refute Registrant's understanding that Petitioner expressly represented that it would not respond to the Discovery Requests. Levang Dec. ¶ 11.

On August 29, 2012, Registrant's counsel emailed Petitioner's counsel requesting that Petitioner's counsel advise us by Thursday, whether Petitioner would produce responses to the Discovery Requests by Friday, August 31, 2012. Otherwise, Registrant would have no choice but to file a motion to compel and/or seek sanctions with respect to the past due discovery responses. Levang Dec. ¶ 12.

On August 30, 2012, Petitioner's counsel apologized regarding the outstanding discovery and with respect to the Discovery Requests represented that "We will try to get something to you if we can't settle." Levang Dec. ¶ 13.

Further, on August 30, 2012, counsel for Registrant contacted Petitioner's counsel via email seeking clarification whether Petitioner would produce responses to the Discovery Requests by Friday, August 31, 2012. Levang Dec. ¶ 14.

As of the filing of this Motion, the parties have yet to reach settlement. Levang Dec. ¶ 15.

As of the filing of the above-captioned motion, Registrant has not received any documents or responses from Petitioner with respect to the Discovery Requests. Levang Dec. ¶ 16.

Counsel for Registrant has made a good faith effort to resolve the issues presented in this Motion with Petitioner. Levang Dec. ¶ 17. Nevertheless, Petitioner has refused to respond to Registrant's Discovery Requests. Accordingly, Registrant has no choice but to file this instant Motion.

II. Law and Argument

A. The Board Should Enter Dismissal or Entry of Default Judgment Sanctions Against Petitioner for its Failure to Provide Responses to Registrant's Discovery Requests.

As stated in the TBMP:

"The motion for sanctions under 37 CFR § 2.120(g)(2) is available for... interrogatories, and requests for production of documents and things, and lies where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made. A motion for sanctions for failure to provide initial disclosures may be made when a party has expressly stated to its adversary that it does not intend to meet its obligation."

TBMP § 527.01(b)

In the present instance, Petitioner has not provided any responses to Registrant's Discovery Requests. Petitioner has even acknowledged as much in its Motion for Extension of the Discovery Period that was submitted to the Board. Further, Petitioner has indicated that it will not provide discovery responses as Petitioner has never explicitly refuted Registrant's understanding of Petitioner's counsel's statement of August 24, 2012. Any subsequent representations by Petitioner's counsel regarding discovery responses is that Petitioner will produce responses on the condition that the parties do not reach a settlement. However, discovery obligations/deadlines are independent of settlement discussions. Besides, such a condition removes a hard deadline to respond to discovery with a subjective, unknown future deadline at Petitioner's choosing. Petitioner's placement of an open-ended condition on its production of discovery responses is a dilatory tactic and should not be viewed by this Board as a representation by Registrant that it will provide discovery responses.

Rule 120(g)(1) authorizes the Board to "make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure." Rule 37(b)(2) authorizes "dismissing the action or proceeding in whole or in part" or "rendering a default judgment against the disobedient party." FRCP § 37(b)(2)(A)(v) and (vi). Further, the Board may enter a sanction "striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party." TBMP § 527.01(b).

Petitioner initiated this cancellation proceeding against Registrant, but has not participated in discovery by continuing to delay providing responses and by placing unfounded conditions on its submission of responses. Petitioner's actions are preventing Registrant from

gathering the information and evidence needed to evaluate and to defend against Petitioner's claims.

B. In the Alternative, Petitioner Should be Compelled to Respond Without Objection to Registrant's First Set of Interrogatories and First Request for Production of Documents.

Federal Rule of Civil Procedure 37(a)(1) and (a)(3)(B) and Trademark Rule of Practice 2.120(e) provide that a discovering party may move for an order compelling responses to interrogatories and requests for production of documents when a party refuses to respond.

As set forth above, Registrant has made a good faith effort to resolve this issue of non-production with Petitioner by agreeing to multiple extensions of time, inquiring about whether responses would be forthcoming, continuing to seek responses after the response deadline, and even warning Petitioner that Registrant would have to file this instant motion if Petitioner did not respond to the Discovery Requests. However, after all of these reasonable, good faith efforts, Registrant has yet to receive any responses to its Discovery Requests.

Petitioner has failed to respond in any way whatsoever to Registrant's Discovery Requests. Therefore, the Board should compel Petitioner to respond to Registrant's First Set of Interrogatories. See, TBMP § 523.01; Jain v. Ramparts Inc., 49 USPQ2d 1429 (TTAB 1998) (interrogatories and document requests); Miss Am. Pageant v. Petite Prods. Inc., 17 USPQ2d 1067, 1070 (TTAB 1990) (granting motion to compel responses to interrogatories); Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral and Maxillofacial Surgeons, 201 USPQ 531, 534 (TTAB 1979) (granting motion to compel responses to discovery requests relating to third-party uses of Petitioner's mark); Miller & Fink Corp. v. Servicemaster Hosp. Corp., 184 USPQ 495, 496

(TTAB 1975) (granting motion to compel responses to interrogatories regarding Petitioner's claims of distinctiveness).

Further, the Board should compel Petitioner to respond to Registrant's First Set of Requests for Production. Federal Rule of Civil Procedure 37(a)(3)(B) and Trademark Rule of Practice 2.120(e) provide that a discovering party may move for an order compelling production of responsive documents when a party refuses to respond to discovery requests. Because Applicant has failed to produce any responsive documents, the Board should compel Applicant to immediately produce responsive documents. See, TBMP § 523.01; *Miss Am. Pageant*, 17 USPQ2d at 1070 (granting motion to compel production of documents); *Am. Soc'y of Oral Surgeons*, 201 USPQ at 534 (granting motion to compel production of documents); *Johnson & Johnson v. Diamond Med., Inc.*, 183 USPQ 615, 617 (TTAB 1974) (granting motion to compel production of documents).

Further, when a party fails to respond timely to a request for discovery, any objections a party may have on the merits of any discovery request are waived. See, TBMP § 527.01(c); *MacMillan Bloedal Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (“[A] party who fails to respond to a request for discovery during the time allowed therefor is deemed by the Board to have forfeited his right to object to the request on its merits”); *Crane Co v. Shimano Indus. Co.*, 184 USPQ 691, 691 (TTAB 1975) (“Inasmuch as Petitioner failed to respond to the interrogatories on or before [the deadline], or to request an extension of its time to do so prior to the aforesaid date, Petitioner has waived its right to object to the interrogatories on their merits and must reply to them as put.”). Because Petitioner has failed to provide any response to the Discovery Requests and is now two weeks past the deadline to do so, Petitioner is deemed to have waived its right to object to any request.

Petitioner is aware that its responses to Registrant's Discovery Requests are overdue and has yet to provide any response to those requests. Accordingly, the Board should compel Petitioner to immediately respond without objection to Registrant's First Set of Interrogatories and First Request for Production of Documents.

C. The Board Should Allow Registrant an Opportunity to Conduct Follow-Up Discovery Given Petitioner's Failure to Respond to the Discovery Requests.

Registrant respectfully requests that the Board extend the discovery period only as to Registrant to allow for the opportunity to take "follow-up" discovery. As stated in the TBMP:

"At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto... deprive its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion."

TBMP § 403.04.

Further, this Board should not allow Petitioner to benefit from its lack of participation in the discovery process. As of the filing of this Motion, Petitioner has had about 70 days to provide responses to the Discovery Requests, but has not produced any responses whatsoever. Further, Petitioner is about two weeks past the latest extension of time to provide responses to the Discovery Requests and has not provided any whatsoever. It is manifestly unjust for Petitioner to actively hamper Registrant's discovery efforts.

As set forth above, Petitioner has failed to provide any responses to the Discovery Requests by the deadline of August 24, 2012. Petitioner has failed to meet its discovery obligations to the detriment of Registrant. Accordingly, Registrant requests that the Board provides Registrant only, with a 30-day "follow-up" discovery period, after receipt of

Petitioner's response to the Discovery Requests, or any other amount of time which the Board deems just and reasonable.

III. Conclusion

For the foregoing reasons, Registrant respectfully requests that the Board dismiss the above-captioned cancellation proceeding as a sanction for Petitioner's failure to respond to discovery; or in the alternative, compel Petitioner to respond without objections to Registrant's First Set of Interrogatories and First Set of Requests for Production of Documents and provide a follow-up discovery period as to Registrant only.

Dated: September 6, 2012

By: Bradley J. Levang

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Attorneys for Registrant,
PAISANOS PASTA, LLC

CERTIFICATE OF SERVICE


The undersigned certifies that based on agreement by the parties to accept service by electronic transmission, a copy of **Paisanos Pasta, LLC's Motion for Sanctions, and in the Alternative, to Compel Responses and Production Responsive to its Discovery Requests** was served on Andoni, Inc. on September 6, 2012, by being sent via electronic mail, as well as the original being sent by first class mail with postage prepaid, and addressed to Andoni, Inc.'s attorney of record as follows:

Richard C. Litman
Walter E. Kubitz
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8955 Center Street
Manassas, VA 20110

Email: efile@4patent.com and wkubitz@litmanlaw.com

Dated: September 6, 2012

By: _____


Bradley J. Levang